

REMARKS

Claims 34 through 45 are pending in this Application. Claim 34 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Fig. 2 and the related discussion thereof in the written description of the specification. Applicant submits that the present Amendment does not generate any new matter issue.

Title

The Examiner asserted that the title is not descriptive and required a new title. In response the title has been amended consistent with the Examiner's request.

Claims 34, 35 and 45 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Kumagi.

In the statement of rejection the Examiner referred to Figs. 5A – 5C of Kumagi, asserting the disclosure of a semiconductor device corresponding to that claimed and identifying semiconductor layer 1' on substrate 1 with an insulating layer 14 therebetween, MOS transistors 6 of a first conductivity type, MOS transistors 3 of a second conductivity type, first insulating layer 13 between transistor 6, and a second insulating film, also identified by reference numeral 13, said to separate the regions of different conductivity type. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art.

Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); Crown Operations International Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917

(*Fed. Cir. 2002*). There are significant structural differences between the claimed semiconductor device and Kumagi's semiconductor device that scotch the factual determination that Kumagi discloses a semiconductor device identically corresponding to that claimed.

Specifically, claim 34 has been clarified by reciting that the second isolation region, which includes the second insulating film, is in contact with the insulating layer formed on the semiconductor substrate. No such structure is disclosed or suggested by Kumagi.

Indeed, the Examiner identified layer 13 as the second insulating film in Kumagi semiconductor device. But layer 13 does not actually isolate the first and second active regions from each other, to begin with, let alone by extending down to the buried oxide layer 14.

The above argued structural differences between the claimed semiconductor device and Kumagi's semiconductor device undermine the factual determination that Kumagi discloses a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (*Fed. Cir. 1992*); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (*Fed. Cir. 1986*). Applicant, therefore, submits that the imposed rejection of claims 34, 35 and 45 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kumagi is not factually viable and, hence, solicits withdrawal therefore.

Claims 36 and 37 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kumagi in view of Ogoh.

This rejection is traversed. Claims 36 and 37 depend from independent claim 34. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 36 and 37 under 35 U.S.C. § 103 for obviousness predicated upon Kumagi.

The secondary reference to Ogoh does not cure the argued deficiencies of Kumagi. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claims 36 and 37 under 35 U.S.C. § 103 for obviousness predicated upon Kumagi in view of Ogoh is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 38 through 40 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kumagi in view of Nagakubo et al.

In the statement of the rejection the Examiner referred to Fig. 6 of Nagakubo et al. and concluded that one having ordinary skill in the art would have been motivated to modify Kumagi's semiconductor device by forming the second insulating film completely through the semiconductor layer to separate the active regions into island substrate regions. The rejection is traversed.

Applicant strenuously argues that the Examiner did not establish the requisite fact-based motivation to support the obviousness conclusion. In order to establish the requisite realistic motivation the Examiner must make clear and particular factual findings as to a specific understanding with specific technological principle and, based upon such factual findings explain **why** one having ordinary skill in the art would have been realistically motivated to modify **particular prior art**, in this case the **specific semiconductor device disclosed by Kumagi** to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002);

Ecolochem Inc. v. Southern California Edison, Co., 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembicza*k, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). That burden has not been discharged.

Applicant stresses that the semiconductor device disclosed by Nagakubo et al. is **completely different**, repeat **completely different**, from Kumagi's semiconductor device. In fact, Nagakubo et al. do not even disclose CMOS transistors on an **SOI substrate**. Significantly, insulating films 110, 111 in the Fig. 6 device of Nagakubo et al. do **not even separate** regions of **different** conductivity types, as in the claimed invention. These **dramatic and significant differences** between Kumagi's semiconductor device on the one hand and the semiconductor device disclosed by Nagakubo et al. on the other hand, undermine the asserted motivation.

Further, it is not apparent and the Examiner did not factually establish that Kumagi even desires the active regions to be formed into island regions. The Examiner simply failed to provide fact-based reasoning explaining **why** one having ordinary skill in the art would somehow have been realistically motivated to restructure Kumagi's semiconductor device, which is based upon an SOI substrate, in view of an isolated feature disclosed by Nagakubo et al. in a **totally different type of device**. *In re Lee, supra*; *Ecolochem Inc. v. Southern California Edison, supra*; *In re Kotzab, supra*; *In re Dembicza*k, *supra*; *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

Based upon the foregoing Applicant submits that the imposed rejection of claims 38 through 40 under 35 U.S.C. § 103 for obviousness predicated upon Kumagi in view of Nagakubo et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 41 through 44 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kumagi in view of Nagakubo et al. and Yatsuda et al.

This rejection is traversed. Claims 41 through 44 depend from claim 38. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 38 under 35 U.S.C. § 103 for obviousness predicated upon Kumagi in view of Nagakubo et al. The additional reference to Yatsuda et al. does not cure the argued deficiencies in the attempted combination and Kumagi and Nagakubo et al. Accordingly, even if all the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result.

Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.

Applicant, therefore, submits that the imposed rejection of claims 41 through 44 under 35 U.S.C. § 103 for obviousness predicated by Kumagi in view of Nagakubo et al. and Yatsuda et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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